



PATENT
Docket No. 212302000720

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Tamara Alcaraz
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Mario ASSENMACHER et al.

Serial No.: 09/309,199

Filing Date: May 10, 1999

For: DIRECT SELECTION OF ANTIGEN-SPECIFIC T CELLS, COMPOSITIONS OBTAINED THEREBY AND METHODS OF USE THEREOF

Examiner: M. Belyavskyi

Group Art Unit: 1644

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RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This is in response to the Office Action dated March 19, 2002, paper number 20 for which a response is due on April 19, 2002. Accordingly, this response is timely filed.

Applicants respectfully traverse the Restriction and submit that the asserted basis for the Restriction is insufficient. Applicants thus respectfully request the Restriction be reviewed and either withdrawn or modified for the following reasons.

The Examiner has reiterated a previous restriction requirement (which is not traversed) and required new restriction as shown below. (The descriptions of groups as used by the Office are reproduced).

I. Claims 1-13, 74-87, drawn to a method for obtaining a cell population enriched in antigen-specific T-cells, classified in Class 435, subclass 2, 374.

II. Claims 14-21, 33, 88-97, drawn to method to label antigen-specific T cells, classified in Class 435, subclass 7.2, 373.

III. Claims 22-28, 98, drawn to composition, comprising of labeled antigen-specific T cells, classified in Class 435, subclass 325.

IV. Claims 29-30, drawn to cells and progeny, classified in Class 424, subclass 93.1.

V. Claim 31, drawn to a method of analyzing a population of cells, classified in Class 435, subclass 7.1.

VI. Claim 32, drawn to a method of determining a distribution of secretory activity in a cell, classified in Class 435, subclass 375.

VII. Claims 34-50, 99-115, drawn to a method for identifying antigen-specific T cells, classified in Class 435, subclass 326.

A restriction requirement is proper *only* if, there would be a *serious burden* of search and examination absent restriction. See MPEP § 803. The present restriction requirement places previously elected and previously examined claims 1-50 in seven groups.

The Office has previously searched and examined the claimed subject matter. This is reflected in (1) a previous restriction requirement, (2) a first Office Action, (3) a second Office Action in response to an amendment by the Applicants, (4) an interview, and (5) an Advisory Action in response to a second amendment by the Applicants. Further, the Office has entered and responded to an amendment filed November 8, 2001. Although some of claims 1-50 were amended in the response filed November 18, 2001, none of these amendments adds to the burden on the Office. Further, new claims 74-115 are similar to those previously examined (see the groupings recited by the Office in the restriction requirement) and do not change the examination burden.

Applicants respectfully submit it is abundantly clear that the search and substantive examination places no undue burden on the Office. In contrast, the requirement that applicants now undertake the expense of filing an additional six divisional applications, after 3 years of previous prosecution, is abundantly unfair to applicants. Applicants respectfully submit that the restriction requirement is improper for the reasons above. However, should the Office disagree,

Applicants reserve all rights, including the right to raise additional issues in the future (e.g., Applicants have not reviewed the Manual of Classification but note that 6 of the 7 proposed groups have been designated in the same class, and reserve the right to request reconsideration of the designation of different subclasses).

Applicants submit that, at minimum, groups I, II, and V-VII should be rejoined and examined together. In the event that the instant Restriction Requirement is maintained despite the above discussion, Applicants hereby elect Group II, claims 14-21, 33, and 88-97, with traverse for the reasons presented above. Applicants expressly reserve the right under 35 U.S.C. § 121 to file a divisional application directed to the nonelected subject matter during the pendency of this application, or an application claiming priority from this application.

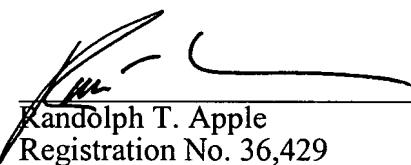
Applicants request examination of the elected subject matter on the merits.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **212302000720**. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

Dated: April 18, 2002

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